

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

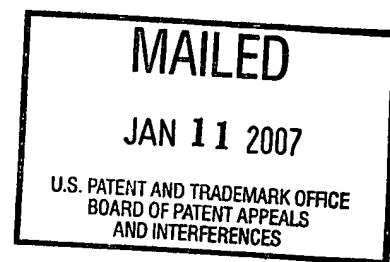
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHERIF SAFWAT

Appeal No. 2006-3337
Application No. 09/674,443
Technology Center 3600

HEARD: December 14, 2006



Before CRAWFORD, GROSS, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims
1-47, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a fishhook or artificial lure for inducing a strike response in fish (specification, page 1). In particular, the invention includes an electret (specification, page 21).

Claim 1 is representative of the invention, and is reproduced as follows:

A bioelectric simulating fishhook comprising:

- a shank having an eye formed at an end thereof, the eye adapting the fishhook for coupling to a fishing line;
- a bend formed at an end of the shank distal from the eye;
- a point formed at an end of the bend distal from the shank;
- and
- a self-contained bioelectric simulating means which, to induce a strike response in fish, includes an electret and is disposed on the shank.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Richard	4,715,142	Dec. 29, 1987
Barfield	4,893,430	Jun. 16, 1990
Massie	4,970,808	Nov. 20, 1990
Rodgers	5,697,182	Dec. 16, 1997

Claims 1-3, 12-15, 24, 26, 40, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Richard.

Claims 4-11, 16, 25, and 42-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Richard in view of Barfield.

Claims 22-24, and 37-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Massie.

Claims 17-22, and 27-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rodgers.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed August 30, 2006) and the Office action (mailed July 1, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (filed August 9, 2004) and reply brief (filed January 18, 2005) for the appellant's arguments thereagainst.

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 C.F.R. § 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with the rejection of claims 1-3, 12-15, 24, 26, 40 and 41 under 35 U.S.C. § 103(a) as being unpatentable over Richard. We turn first to claim 1.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See *id.*; *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ

785, 788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (Office action mailed July 1, 2003¹, page 3) is that Richard discloses a fishhook having a self-contained bioelectric simulating means which is the interaction between anode 4, plastic band 7, and gold coating 8. The examiner asserts (*id.*), that "it would have been obvious to provide Richard with the electret disposed on the shank adjacent the hook eye since a breakage at this point would also cause the hook to fail." This position taken by the examiner implies that Richard describes an electret, and that it would have been obvious to locate the electret adjacent the hook eye. However, in the answer, the examiner takes the position (page 4) that Richard does not describe an electret, but that Richard discloses an anode and cathode separated by an insulator, which, in the opinion of the examiner, creates a persistent dielectric polarization. The examiner argues that it would have been obvious to provide Richard with a known electret since merely replacing one bioelectric simulator with another would have been obvious since the function is the same. We find from the position taken by the examiner in the answer that the examiner acknowledges that Richard does not disclose an electret, but asserts that to substitute an electret for the anode, cathode and insulator of Richard would have been obvious since the function is the same.

Appellant asserts (brief, page 19) that none of the references applied against the claims disclose or suggest an electret. Appellant (brief, page 9) points to

¹ The examiner's answer refers to the Office action mailed July 1, 2003 for the rejection of the claims. Although PTO practice, as of the date the examiner's answer was mailed, does not permit the examiner to refer back to a previous Office action in an examiner's answer, we decline to remand the application to the examiner, but rather remind the examiner of this change in practice and procedure; see MPEP § 1207.02.

definitions of an electret from the American Heritage Dictionary and the Columbia Encyclopedia². Appellant disputes (reply brief, page 7) the examiner's finding that Richard provides a "persistent ... polarization." It is argued that in Richard, there is no galvanic action when the fishhook remains in air [i.e., is not in water] so that any polarization is not "persistent." It is further argued (reply brief, page 12) that the proposed modifications to Richard, advanced by the examiner, would make the Richard reference inoperative for its intended purpose of breaking after being immersed in seawater for some interval of time.

From our review of the record, we note that claim 1 requires a fishhook including an electret. As noted by the examiner in the answer, as discussed, *supra*, Richard discloses the use of an anode initially covered by a dielectric, and a cathode, for dissolving the fishhook after it has been in sea water for some period of time. However, Richard does not describe an electret. Thus, the issue before us is whether it would have been obvious to have replaced the anode, cathode and dielectric of Richard with an electret as advanced by the examiner. From our review of the record, we note that although the specification describes the use of an electret, we find no specific definition of the term. Rather than rely on the general definitions provided by appellant, we rely upon the definition of the term "electret" found in a scientific Dictionary, i.e., the McGraw-Hill Dictionary of Scientific Terms³. The term "electret" is defined as "[a] solid dielectric possessing persistent electric polarization...." In addition, in a reference located by the Board, U.S.

² We note that the reference to the American Heritage Dictionary is not dated and that the publication date of the Columbia Encyclopedia is subsequent to appellant's filing date.

³ © 1994. A copy of the pertinent page is enclosed with the Decision.

Patent No. 3,632,443⁴ we find that a permanently polarized dielectric material is referred to as an electret (col. 1, lines 9 and 10). We note these definitions of the term "electret."

From our review of Richard, we agree with appellant that although an electric field is created when the fishhook is immersed in water, no electric field is produced when the anode and cathode are in air. Thus, the anode, cathode and dielectric of Richard do not provide a persistent polarization, as asserted by the examiner.

We are not persuaded by the examiner's assertion (answer, page 4) that it would have been obvious to provide Richard with an electret as a mere replacement of one biosimulator for another because the use of an anode, cathode, and dielectric in Richard is not a disclosure or suggestion of an electret.

Nor are we persuaded by appellant's assertion during the Oral Hearing that an electret, because it is persistent, will not dissolve in sea water. In another reference located by the Board, U.S. Published application 2003/0055179⁵, we find that though the reference was not filed prior to appellant's filing date, the reference describes using an electret in a fishhook for the purpose of being environmentally degradable.

From all of the above, we are not persuaded by the examiner that an artisan would have been motivated to replace the anode, cathode and dielectric of Richard with an electret. Accordingly, we find that the examiner has failed to establish a prima facie case of obviousness of claim 1. It follows that we cannot sustain the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Richard.

⁴ A copy of the document is enclosed with the Decision.

⁵ A copy of the pertinent pages of this document are enclosed with the Decision.

fishing gear having an electret, we cannot sustain the rejection of these claims as well, or of dependent claims 2, 3, 12-15, 26, and 41.

We turn next to the rejection of claims 4-11, 16, 25, and 42-47 under 35 U.S.C. § 103(a) as being unpatentable over Richard in view of Barfield. We cannot sustain the rejection of these claims because Barfield fails to make up for the basic deficiencies of Richard.

We turn next to the rejection of claims 22-24 and 37-39 under 35 U.S.C. § 103(a) as being unpatentable over Massie. We cannot sustain the rejection of these claims because Massie, like Richards fails to describe or suggest fishing gear including an electret.

We turn next to the rejection of claims 17-22 and 27-36 under 35 U.S.C. § 103(a) as being unpatentable over Rodgers. We cannot sustain the rejection of these claims because Rodgers, like Richard and Massie, fails to teach or suggest fishing gear including an electret.


CONCLUSION

To summarize, the decision of the examiner to reject claims 1-47 under 35 U.S.C. § 103 is reversed.

REVERSED

MURRIEL E. CRAWFORD
Administrative Patent Judge

Anita Pellman Gross
ANITA PELLMAN GROSS
Administrative Patent Judge


STUART S. LEVY
Administrative Patent Judge

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